selected information encoded on the product cards in a database associated with the central computing station, and finally approving activation;

d) transferring a respective activated product card from a prescriber to a patient;

e) the patient in turn presenting the activated product card to a participating pharmacy;

f) validating the activated product card at the pharmacy by the pharmacy communicatively linking the presented product card with the central computing station and verifying that the presented product card has in fact been activated;

g) after validating the presented product card, the pharmacy then dispensing the approved pharmaceutical product to the patient; and

h) accounting to the participating pharmacies for pharmaceutical product dispensed.

2. The method of claim 1 wherein the product cards when delivered to a prescriber are in an unactivated state and wherein the activation of the product cards takes place while the product cards are in the possession of a prescriber.

7. The method of claim 6 wherein authorization for both prescribers and pharmacies is established in part at least by issuing a uniquely identifying authorizing media to each participating prescriber and pharmacy and wherein the step of authorization entails prescribers and pharmacies establishing a communication link between the issued authorizing media and the central computing station wherein the central computing station effectively scans the issued authorizing media so as to authenticate the authorizing media.

15. The method of claim 13, wherein prescribers activate the pharmaceutical product media prior to the pharmaceutical product media being issued to a patient, and wherein the

activation by the prescriber includes the prescriber communicatively linking the pharmaceutical product media to a central computing station wherein the central computing station records encoded information from the pharmaceutical product media into a database associated with the central computing station, and wherein validation by the pharmacy includes communicatively linking the presented pharmaceutical product media with the central computing station to determine if the pharmaceutical product media has in fact been activated by a prescriber.

Please add new claims 17-28.

17. The method of claim 11 wherein issuing the pharmaceutical product media and activating the pharmaceutical product media are separate steps.

18. The method of claim 11 wherein the steps of issuing the product media, activating the product media, transferring the activated product media and presenting the product media are performed in the order set forth herein.

19. The method of claim 11 wherein presenting the pharmaceutical product media to the pharmacy and the dispensing of the identified pharmaceutical product is conditioned upon the prior activation of the pharmaceutical product media.

20. The method of claim 19 wherein activating the pharmaceutical product media is conditioned upon the prior issuance of the pharmaceutical product media.

21. The method of claim 11 including issuing the pharmaceutical product media in an inactive state and wherein in activating the product media the media is converted from the inactive state to an active state.

22. The method of claim 21 wherein in the inactive state the pharmacy cannot deliver the identified pharmaceutical product to a person presenting the pharmaceutical product media; and wherein in the active state the pharmacy may deliver the pharmaceutical product identified by the media presented.

23. The method of claim 11 including storing selected information on the pharmaceutical product media in a database.

24. The method of claim 23 including recording in the database that a particular pharmaceutical product media has been activated.

25. The method of claim 24 further including recording information in the database that indicates that the product media has been presented to a pharmacy and that the pharmacy has delivered the pharmaceutical product identified on the media presented.

26. The method of claim 11 including recording information relative to the product media in a database; and providing communication links between a series of prescribers and the database, and between a series of pharmacies in the database.

27. The method of claim 26 wherein in activating the product media, the prescriber communicates information to the database that identifies the product media that the prescriber desires to activate.

28. The method of claim 26 wherein when the product media is presented to the pharmacy, the pharmacy communicates information to the database that identifies the product media and by communicating with the database the pharmacy determines if the product media has been activated and if activated the pharmacy communicates information relative to the product media that indicates that the particular pharmaceutical product identified by the product media has been delivered to a person.

REMARKS

The comments of the Examiner as set forth in the office action have been carefully studied and reviewed. In this response, claims 1, 2, 7 and 15 have been amended. New claims 17-28 have been added. For the reasons set forth below it is respectfully urged that all claims presently pending are in condition for allowance.

First, the Examiner has raised a number of Section 112 concerns. These are well taken. Claims 1, 2, 7 and 15 have been amended to address the Examiner's concern. Also, the Examiner has lodged an obviousness type double patenting rejection. Applicant will, in the very near future, submit a terminal disclaimer that will rectify and overcome this obviousness type double patenting rejection.

Claims 1-8 and 11-16 stand rejected under Section 103 as being obvious in view of Edelson et al. (Edelson) taken in view of Yoshino. Claims 9 and 10 are rejected as being obvious over Edelson.

Turning to the cited art, the Edelson patent is a prescription management system. That is, from a review of the Edelson patent it is seen that the discloser relates to a program to assist doctors with writing prescriptions at the point of care. For example, once the doctor makes a diagnosis, the Edelson program or system will tell the doctor what medication options that he or she has to treat a particular disease, infection, disorder, etc. In the final analysis, Edelson is only a system for electronically creating prescriptions for the doctor.

Yoshino relates to an IC card, that is an integrated circuit card. This integrated circuit card has a display on it. When a patient reaches the hospital the patient is given an IC card. The display on the IC card would provide guidance to the patient that assists the patient in moving through the hospital and to various examination sites.

In the end, neither Edelson or Yoshino disclose or suggest a system or method for managing the dispensing of pharmaceutical products in the manner claimed by Applicant.

The burden is on the Patent Office to establish a prima facie case of obviousness. The Patent Office must meet two separate requirements. First, the primary reference, that is Edelson in this case, as modified must show each and every element and limitation of each claim rejected. This requires a claim by claim and element by element analysis where the Patent Office points out how the modified primary reference meets each rejected claim and each and every element and limitation of the claim.

Secondly, in order to make out a prima facie case of obviousness and to prevent a hindsight based obviousness rejection, the Federal Circuit has long held that there must be a motivation or suggestion to combine references, or in the case of a single reference, there must be a motivation to modify. This test is viewed from the perspective of a person of ordinary skill in the art. That is, a person of ordinary skill in the art must be motivated to modify the primary reference. In order for there to be a proper motivation there must be an advantage to be gained or a reason that would induce a person of ordinary skill in the art to make the modification. The stated motivation must be concrete and supported by substantial evidence. The motivation cannot be conclusionary.

Turning to the rejection of claims 1-8 and 11-16, it is difficult to understand how the Examiner is applying Edelson and Yoshino. There is no element by element analysis, and certainly no claim by claim analysis set forth. In particular, at page 6 of the office action the Examiner states that Edelson teaches an automated method for creating patient prescriptions based on health conditions and for providing the created prescriptions to pharmacists. This has nothing to do with the claimed invention as expressed in either claim 1 or 11. Applicant's invention is not concerned with automatically creating prescriptions and the fact that these automatically created prescriptions are ultimately presented to pharmacists is of no significance in terms of the claimed invention.

Next at page 6 of the office action the Examiner notes that Edelson further teaches a method that uses a plurality of security and authentication measures to limit access to patient medical data to authorized users. Again, this has nothing to do with Applicant's claimed invention. This does not meet a single step in Applicant's method claims. Applicant is not claiming a security system for protecting medical records of patients. An analysis of Applicant's claims shows that authentication relates to the pharmaceutical product media or pharmaceutical product card. Then the Examiner notes that Edelson further discloses a method that provides prescription fulfillment information to pharmacists to ensure that prescriptions have not been

filled multiple times, to avoid system abuse. This feature found in Edelson has nothing to do with the claimed invention. Applicant's claimed invention revolves around the pharmaceutical product media or the pharmaceutical product cards, and provides a management process or system that assures that certain pharmaceutical products identified on the product media is dispensed according to certain criteria.

The above analysis is the extent of what the Examiner maintains is common between Edelson and the claimed invention. However, in reviewing claim 1, for example, the Examiner has not addressed a significant number of the expressed elements of the claim. For example, there is nothing said about the step of paragraph a in claim 1, calling for forming a series of product cards by encoding on respective product cards information that identifies a particular pharmaceutical product. This element of Applicant's invention is simply not shown by either Edelson or Yoshino. Next, claim 1 includes the step of issuing the product cards to participating prescribers. This particular element is not addressed in the office action. Again, neither Edelson nor Yoshino show this element and particularly the issuing of these particular cards.

Furthermore, there is no discussion in the office action of these particular cards being activated and these particular cards being transferred to patients after activation. Also, in terms of claim 1, there is no teaching of the presentation step set forth in paragraph e and the validation step set forth in paragraph f of claim 1. Nor is there any discussion relating to paragraphs g and h of claim 1.

Therefore, even if there was a motivation to combine Yoshino with Edelson, the modified Edelson disclosure would fall far short of showing each and every element of the claimed invention.

Furthermore, there is no motivation to combine Yoshino with Edelson. The Examiner takes the position that one would have been motivated to do so in order to reduce the risk of prescription abuse as suggested by Edelson. It is not all clear how combining Yoshino with Edelson would accomplish this objective. Again, the crux of Edelson is to automatically

generate prescriptions. The stated motivation for combining Yoshino and Edelson is conclusionary and is not supported by substantial evidence. The two disclosures are very different and are aimed at solving two entirely different problems that are in no way related to Applicant's invention of being able to manage the distribution of a pharmaceutical product that is identified on a product media or product card.

Turning now to the rejection of claims 9 and 10, the Examiner simply relies on the Edelson patent and maintains that the invention of claim 9 would be obvious. It should be pointed out that claim 9 claims more than simply a central computing station and the two arrays of communication terminals. A part of the system is the pharmaceutical product media that is particularly encoded with information identifying a particular pharmaceutical product. Claim 9 particularly claims the relationship between the product media and the communication terminals and the central computing system. The Edelson patent does not teach, in any form, the pharmaceutical product media with the claimed encoded information on it. The product media identifies a pharmaceutical product. The fact that the product media is encoded with this specific information is material to the claim and forms a part of the claimed system and therefore, defines over the Edelson patent.

The Examiner notes that Edelson does not specifically teach the pharmaceutical media in the form of individual media slips. That is, of course, true. But moreover, Edelson does not teach the pharmaceutical product media encoded with information that identifies a particular pharmaceutical product. Therefore, even if there was some motivation to modify Edelson, that modification would not produce the claimed system. The fact that Edelson might disclose some type of forms does not mean that Edelson describes these particular encoded product media. They are not the same and consequently the claimed invention is not obvious.

The Examiner has noted that one would be motivated to modify Edelson to make his system more marketable by maximizing its flexibility and compatibility with a number of legacy